

REMARKS

Claims 24, 26-30 and 39-44 are in the application. Claims 41-44 have been amended to replace the word "or" with the word "and" in the Markush group.

Applicant respectfully urges the Examiner to enter this amendment for the following reasons:

- 1) It removes a minor informality only.
- 2) It corrects something that was in these claims since at least early 2006.
- 3) It responds to a request by the Examiner.
- 4) It does not require any new search and does not raise a new issue.
- 5) It places claims 41-44 in better condition for allowance or appeal.

The invention is a laminate containing a nonwoven fibrous mat containing a major portion of non-cellulosic fibers having an average fiber diameter of at least about 10 microns and up to 20 microns, the fibrous mat having a coating on a surface, the coating having an exposed surface having a surface smoothness Ra of no greater than about 13 microns, the coating comprising a minor amount of clay, a minor amount of binder and a major amount of inorganic filler. The novelty of the laminate of the invention lies in the type of coated mat and the degree of smoothness of the exposed surface of the coated fibrous mat. The claimed laminate provides a laminate made using something other than a cellulosic fiber mat, to avoid potential mold problems, and yet still having a degree of smoothness needed in the industry for an exposed surface ready for painting, wallpapering, etc. The high degree of smoothness on a surface of the claimed laminate is due to the coating, applied to the mat, being dried while in contact with a smooth surface.

Claims 41-44 were rejected under 35 USC 112, second paragraph as being indefinite because the word "or" was used in the Markush group in the claims instead of the word "and". The above amendment corrects this informality and applicant respectfully requests the Examiner to withdraw this rejection and to allow all of the claims.

Claims 24, 26-30, 39-44 stand rejected under 35 USC 103 as being unpatentable over Jaffee et al '187 in view of Leclercq. The Examiner urges that it is presumed that the mat or mats disclosed in this reference have the degree of surface smoothness of the claimed invention, but no proof is provided by the Examiner to support this presumption. This presumption is not correct as evidenced by the Examples, specifically Example 1 vs Example 2 and Example 7 vs Example 8, provided in the present application. The Examiner appears to be ignoring this evidence. Other examples show that different kinds of mats and different kinds of coatings, when made according to the non-elected present invention have the surface smoothness recited in the claims. Applicant believes that these comparative examples establish prima facie that the surface of the claimed laminate is substantially smoother than that of the mats reasonably taught by Jaffee and Leclercq. Applicant sees nothing in either of these references or in the present specification reasonably suggests otherwise.

The coated mats taught by Jaffee et al are dried with the coating exposed to the air and hot gases in the oven, the manner of drying used in Examples 1 and 7, and show that drying in the conventional manner and the manner used by Jaffee et al produces a relatively smooth surface, but not nearly as smooth as possessed by the mats in the laminates of the claimed invention. There is no suggestion in Jaffee et al to at least partially drying the mat and/or the coating while it is in contact a smooth surface. This step in the manufacture of the coated mats is critical to the manufacture of the coated mat of claims of Groups I and II and to the method claims of Group III.

Examples 1 and 2 of the present specification show that when the same mat is coated with the same coating composition, Example 1, coated with essentially the same coating weight (19.9 gms/sq. ft. for Example 1 and 19.3 gms/sq. ft. for Example 2, and then dried in a conventional manner with the coated surface exposed to hot air

and hot gases shows that the surface is not nearly so smooth as the surface of the mat made according to the invention, i.e. the Example 2 mat having the coating against a smooth surface during drying, had an Ra of 1.2 microns, substantially smoother than the Ra of Example 1, 16 microns. This shows clearly that the Examiner's presumption of the surface smoothness of Jaffee et al is incorrect and lacks any reasonable support. Examples 7 (dried in a conventional manner of being exposed to the hot gases in the oven), i.e. like Jaffee '697 and 8 (dried or partially dried in contact with a smooth surface) also provide evidence that the Examiner's presumption is wrong. The surface of the Example 8 mat made according to the invention had a surface smoothness Ra of 1.08 whereas the mat in Example 7, dried as taught by Jaffee et al, had a much lower surface smoothness, an Ra of 18.2 microns and outside the claimed range. The examples in the specification are of sufficient diversity and scope, coupled with reasonable statements made by the applicant in the specification, as to provide reasonable basis for the scope of the claims. The Examiner urges that the method of making the mat is irrelevant to the patentability of the mat, but where the method of making the mat is part of the evidence showing that the prior art mats would not have a smoothness Ra that is greater than that of the claimed mat, the method of making the mat must be considered. Evidence pertinent to patentability must always be considered.

The Examiner states that the arguments regarding the Examples and comparative examples are not persuasive because they are not commensurate with the scope of the applied prior art. The evidence does not have to be commensurate with the scope of the applied prior art, but this is not a reasonable standard. The comparative examples are representative of the prior art coated mats in the fiber diameter (13 microns) and coating weights, although the claimed coating weights are below and at the very low end of the coating weights taught by Leclercq, see paragraphs 0063 and 0065, 200-300 with 250 g/sq. m as exemplary. The coating weight in Example 1 of the present specification is about 214 g/sq. m and in Example 7 is about 183 g/sq. m, the former within the range taught by Leclercq and the latter within the currently claimed range. Nothing in Leclercq teaches that the low end of his coating range produces a rougher surface. Note that the coating weight range in applicant's claimed laminate is about 86 to about 215 g/sq. m. Applicant's mats can have a lower coating weight and still have a smoother surface than prior art coated mats because of the novel method used to make the claimed coated mats. Applicant

believes that the comparative Examples in the specification establish prima facie that the surface of the claimed mats is substantially smoother than that of the coated mats taught by either Jaffee or Leclercq.

Leclercq is cited to show a prior art coating composition for coating fibrous mats intended for use in facing a core of plaster to make a laminate with a mat coating exposed. Leclercq does not disclose the coating method he used to make the coated mats, only that it was a conventional coating process. Therefore, there is no way that applicant could run a trial on a Leclercq coated mat because there are many conventional coating processes and parameters used on each of these processes, but none include the novel coating process of applicant's non-elected invention. Most importantly, Leclercq does not disclose a mat having a coating that was dried in contact with a smooth surface. The very smooth surfaces on the presently claimed laminates is the result of using applicant's novel coating process.

Leclercq discloses a gloss property, but only after applying two coats of paint to the coated mat on the wall board. Also, Leclercq does not disclose the details of the gloss test or provide a standard test number so it is impossible to determine how he conducted this test. Applicant's surface smoothness test is thoroughly described on page 10, lines 17-28 of the specification. In view of the incomplete disclosure of Leclercq on both the coating process used or the gloss test method, it is unreasonable to presume that the surface smoothness of Leclercq's coated mats is the same as that on the laminates claimed herein.

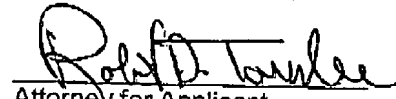
It is well established that a rejection under 35 USC 102 or 35 USC 103 that is based on alleged inherent properties of a prior art product must be reasonable and have some basis in either the prior art reference or in the common knowledge of one skilled in the art. Here, where applicant has provided Examples that show that That is not present here because Jaffee et al did not teach or suggest that his mats had a surface smoothness within the range claimed in this application. Although the mats of Jaffee et al can be used as facers, Jaffee et al did not teach or suggest that the surface would be as smooth as kraft paper, see the present specification at page 3, lines 8-10. It is also well established that where the applicant has shown with evidence that the inherency urged by the Examiner is not reasonable and not correct, the inherency rejection is overcome. The Examiner's apparent ignoring of the

evidence provided by Examples 1 vs 2 and 7 vs 8 seems both unreasonable and in error. The fact that the smooth surface is produced using a novel process does not change or detract from the novelty and nonobviousness of the resultant coated mats of the invention and the novelty and nonobviousness of the claimed laminates containing these coated mats.

Also, Neither Jaffee et al or Leclercq disclose or reasonably suggest the coating composition recited in claim 26 and claims dependent thereon, e.g. Leclercq teaches using a minimum of 25.5 wt percent clay (85% x .30) and up to 66.5% clay (95% x .7), see paragraphs 0043 and 0051 – 0054.

For these reasons applicant believes that these claims are patentable and respectfully requests the Examiner to withdraw this rejection and to allow all of these claims. If the Examiner believes one or more issues still exist, to expedite a disposal of this application, the Examiner is invited to call applicants' attorney at the number below to discuss resolution.

Respectfully submitted,


Attorney for Applicant

Robert D. Touslee
Reg. No. 34,032
Tel. No. 303-978-3927
Fax No. 303-978-2323
Customer No. 29602